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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,469	01/14/2000	Mark A. Smith	1026-026/MMM	8443
21034	7590	12/17/2004	EXAMINER	
IPSOLON LLP 805 SW BROADWAY, #2740 PORTLAND, OR 97205			CHANG, JUNGWON	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/483,469

Applicant(s)

SMITH, MARK A.

Examiner

Jungwon Chang

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 42-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This office action is responsive to amendment filed on 9/17/2004. Claims 1-41 have been canceled and claims 42-47 are newly added. Claims 42-47 are presented for examination.
2. Claim 42 is objected to because of following informalities:  
Line 10, "the user" should be "the text generation system user".  
Appropriate correction is required.
3. Claim 43 is objected to under 37 CFR 1.75(c), as being of improper dependent form. Claim 43 depends on itself. For examination purposes, claim 43 will be considered to be dependent on independent claim 42.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 42, 44 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone et al. (US 6,212,548), hereinafter referred to as DeSimone, in view of

Knight et al. (US 6,493,703), hereinafter referred to as Knight.

6. As to claim 42, DeSimone discloses the invention substantially claimed, including a method of providing social accounting (buddy list; col. 3, lines 39-42; lists of participants; col. 5, lines 15-21; e-mail address, unique names for each participant; col. 5, lines 40-54) in a computer text generation system (chat system; col. 1, lines 26-47; Instant Messaging; col. 2, lines 4-11) comprising:

collecting a plurality of messages (messages) from a plurality of text generation system users (participants) (col. 3, lines 43-58);

persistently displaying (700, fig. 7) the plurality of messages, from each of the plurality of text generation system users, to each user of the plurality of text generation system users (figs. 4-7; col. 1, lines 36-39; col. 3, lines 43-45; col. 4, lines 55-56; col. 16, lines 7-10; col. 17, lines 35-37 and 45-49) so that all previous message are available to the text generation system users (history of conversation; col. 1, lines 39-47; col. 3, lines 48-49; col. 13, line 66 – col. 14, line 40), and the plurality of messages displayed include at least one message not to or from the user (private chat; col. 1, lines 48-67; whisper conversations; col. 2, line 65 – col. 3, line 1; privacy, secrecy; col. 14, lines 52-54).

7. DeSimone discloses chat windows (figs. 3-7). However, DeSimone does not specifically disclose without messages that scroll from a display being lost. Knight discloses scroll bar and control button in online electronic message board system (figs.

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3B-3C; window manipulation tool, i.e., scrolling; col. 11, lines 21-31; control buttons to look at previous message; col. 17, lines 45-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of DeSimone and Knight because Knight's scroll bar and control button would improve the readability of messages of DeSimone's system by allowing the user to continuously view the entire communication history by scrolling up/down to see the earlier communication messages as needed.

8. As to claim 44, DeSimone discloses further comprises displaying the plurality of messages in a threaded discussion message pane (figs. 4-7; col. 1, lines 36-39; col. 3, lines 43-45; col. 16, lines 7-10).

9. As to claim 47, DeSimone discloses further comprising persistently displaying information from at least one past text generation system user (display a history of conversation; col. 1, lines 39-47; col. 3, lines 48-49; col. 4, lines 55-56; col. 13, line 66 – col. 14, line 40; col. 17, lines 35-37 and 45-49).

10. Claims 43, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone et al. (US 6,212,548), Knight et al. (US 6,493,703), further in view of "Official Notice".

11. As to claim 43, DeSimone discloses in which a user of the plurality of users

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having social accounting data updated (if a participant has left/joined the chat room successfully, remove/add this participant from the active list of participants; col. 5, lines 55-66; col. 11, line 48 – col. 12, line 48; col. 13, lines 28-48) and transmitted to each of the plurality of text generation system users (broadcast to participants; col. 5, lines 62-66; col. 9, lines 59-63; col. 11, lines 43-47; col. 15, lines 45-50). However, DeSimone does not specifically use terms “returning user”. DeSimone discloses “add and remove” buttons in chat window (add, figs. 4-7; col. 5, lines 55-66; col. 11, line 48 – col. 12, line 48). Official Notice is taken that both the concept and the advantages of providing for returning user is well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include returning user because add and remove buttons in the chat window would allow a user to flexibly leave a chat session at any time and rejoin the chat session to continue where the user left off.

12. As to claim 45, DeSimone does not specifically disclose messages are listed in a tree structure. However, Knight discloses messages are listed in a tree structure (fig. 1D; fig. 3B; fig. 3C; col. 13, lines 46-62). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of DeSimone and Knight because Knight’s messages in a tree structure would improve managing electronic messages by allowing the user to more quickly search the desired message and more efficiently keep related files with one another.

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13. As to claim 46, DeSimone discloses in which a listing the messages displayed is performed automatically based upon a message heuristic (interest criteria; col. 15, lines 28-36; col. 1, lines 57-59).

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Smith, patent 6,792,448, Nitta et al, patent 6,154,764, Morton et al, patent 6,438,564, Eves et al, patent 6,678,673, Noma et al, 2003/0179222, Kirk et al, patent 6,175,842, Knight, patent 6,571,234, Busey, patent 6,785,708, Liu et al, patent 6,769,012 disclose method and system for allowing users at multiple separate user computers to communicate with each other simultaneously.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jungwon Chang whose telephone number is 571-272-3960. The examiner can normally be reached on 9:30-6:00 (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

*JWC JWC*

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December 10, 2004